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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,697	03/07/2001	Prudence A. McIntosh	705445US1RAF	4028

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EXAMINER

FRENEL, VANEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/800,697

Applicant(s)

MCINTOSH ET AL.

Examiner

Vanel Frenel

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>030701</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Application filed 03/07/01. Claims 1-20 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 11-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

(A) The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 11 nominally recites "a computer-implemented warranty knowledge base construction system" but do not clearly and definitely utilize any technological device in performing the various claimed steps.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

In the present case, claim 11 recites "a computer-implemented warranty knowledge base construction system" in its preamble but does not recite any technological device in the body of the claim in performing the various steps of "processing" within the computer system.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

In the present case, claim 11 as a whole is directed to determining whether the first rule is in an acceptable syntax based upon the stored syntax rules.

As such, this invention produces a useful, concrete, and tangible results as wherein the first rule is used in a knowledge base method to process repair claims.

Claims 11-20 do not recite any application or use of the technological arts, and thus equally rejected under 35U.S.C. 101.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi et al (5,950,169) in view of Apte et al (5,970,464).

(A) As per claim 1, Borghesi discloses a computer-implemented warranty knowledge base construction system, comprising; a user interface for receiving a first rule related repair claim processing (Col.1, lines 44-55); wherein the first rule is used in a knowledge base system to process repair claims (See Col.9, lines 43-67).

Borghesi does not explicitly disclose a rules syntax data store that stores syntax rules for constructing repair claim-related rules; a knowledge base generator module connected to the user interface and to the rules syntax data store for determining whether the first rule is in an acceptable syntax based upon the stored syntax rules.

However, these features are known in the art, as evidenced by Apte. In particular, Apte teaches a rules syntax data store that stores syntax rules for constructing repair claim-related rules (See Apte, Col.3, lines 5-33); a knowledge base generator module connected to the user interface and to the rules syntax data store for

Art Unit: 3626

determining whether the first rule is in an acceptable syntax based upon the stored syntax rules (See Apte, Col.9, lines 4-28).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Apte within the system of Borghesi with the motivation of providing a client server solution that employs JAVA, a network centric language technology, thereby allowing a server based analytic methodology that can be simultaneously accessed across an intranet or internet by several decision makers, from diverse function areas in a firm (See Apte, Col.2, lines 1-6).

(B) As per claim 2, Borghesi discloses the system wherein a knowledge base stores a plurality of repair claim related expert rules to evaluate a repair claim (See Borghesi, Col.5, lines 1-63), said system further comprising: an integrity rules module connected to the knowledge base generator module in order to determine whether the first rule is consistent with respect to at least one of the warranty-related expert rules that is stored in the knowledge base (See Col.6, lines 1-32).

(C) As per claim 3, Apte discloses the system wherein the first rule is incorporated into the knowledge base, said system further comprising: a testing module for testing the knowledge base with testing scenarios (See Fig.13; Col.8, lines 54-67 to Col.9, line 39).

The motivation for combining the respective teachings of Borghesi and Apte are as discussed above in the rejection of claim 1, and incorporated herein.

(D) As per claim 4, Apte discloses the system wherein the first rule is incorporated into the knowledge base, said system further comprising: a testing module for performing regression testing of the knowledge base (The Examiner interprets univariate statistics to be a form of performing regression See Apte, Col.5, lines 12-30).

The motivation for combining the respective teachings of Borghesi and Apte are as discussed above in the rejection of claim 1, and incorporated herein.

(E) As per claim 5, Apte discloses the system further comprising: a reverse engineer module for generating a specification for the knowledge base (See Apte, Fig.11; Col.7, lines 61-67 to Col.8, line 7).

The motivation for combining the respective teachings of Borghesi and Apte are as discussed above in the rejection of claim 1, and incorporated herein.

(F) As per claim 6, Apte discloses the system wherein the specification for the knowledge base includes warranty methods and warranty business rules (See Apte, Col.8, lines 54-67 to Col.9, line 39).

The motivation for combining the respective teachings of Borghesi and Apte are as discussed above in the rejection of claim 1, and incorporated herein.

(G) As per claim 7, Apte discloses the system wherein the first rule contains a high level computer expression, said knowledge base generator evaluating the high level

Art Unit: 3626

expression as to whether the high level expression of the rule is in an acceptable syntax based upon the stored syntax rules (See Apte, Col.6, lines 11-31).

The motivation for combining the respective teachings of Borghesi and Apte are as discussed above in the rejection of claim 1, and incorporated herein.

(H) As per claim 8, Apte discloses the system wherein the knowledge base generator generates a lower level representation of the first rule if the first rule is in an acceptable syntax (See Apte, Fig.10; Col.7, lines 25-59).

The motivation for combining the respective teachings of Borghesi and Apte are as discussed above in the rejection of claim 1, and incorporated herein.

(I) As per claim 9, Apte discloses the system wherein the high level computer expression of the first rule is an English phrase (See Apte, Col.6, lines 45-60), wherein the lower level representation of the first rule is at least one line of programming code (See Apte, Col.6, lines 45-60).

The motivation for combining the respective teachings of Borghesi and Apte are as discussed above in the rejection of claim 1, and incorporated herein.

(J) As per claim 10, Apte discloses the system wherein the programming code is C++ programming code (See Fig.1; Col.3, lines 1-5).

The motivation for combining the respective teachings of Borghesi and Apte are as discussed above in the rejection of claim 1, and incorporated herein.

(K) As per claim 11, Borghesi discloses a computer-implemented warranty knowledge base construction system, comprising the steps of: receiving a first rule related to vehicle repair claim processing (See Borghesi, Col.2, lines 50-67 to Col.3, line 4).

Borghesi does not explicitly disclose storing syntax rules for constructing repair claim-related rules; determining whether the first rule is in an acceptable syntax based upon the stored syntax rules; wherein the first rules in a knowledge base method to process repair claims.

However, these features are known in the art, as evidenced by Apte. In particular, Apte teaches storing syntax rules for constructing repair claim-related rules (See Apte, Col.3, lines 5-33); determining whether the first rule is in an acceptable syntax based upon the stored syntax rules (See Apte, Col.9, lines 4-28); wherein the first rules in a knowledge base method to process repair claims (See Apte, Col.9, lines 4-28).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Apte within the system of Borghesi with the motivation of providing a client server solution that employs JAVA, a network centric language technology, thereby allowing a server based analytic methodology that can be simultaneously accessed across an intranet or internet by several decision makers, from diverse function areas in a firm (See Apte, Col.2, lines 1-6).

(L) Claims 12-20 recite the underlying process steps of the elements of claims 2-10, respectively. As the various elements of claims 2-10 have been shown to be either disclosed by or obvious in view of the collective teachings of Borghesi and Apte, it is readily apparent that the method disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 12-20 are rejected for the same reasons given above for system claims 2-10, and incorporated herein.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not the applied art teaches method for generating predictive models in a computer system (5,692,107) and method for updating file (5,586,313).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on Monday-Thursday from 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

V.F
V.F

May 30, 2005



ALEXANDER KALINOWSKI
PRIMARY EXAMINER